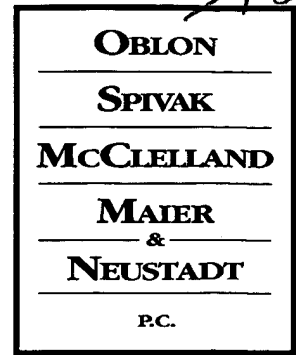




Docket No.: 194667US2PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 09/622,593

Applicants: Bo OLSSON, et al.

RCE Filing JULY 30, 2003

Date:

For: PROCEDURE TO TRANSMIT INFORMATION AT
TELEPHONE ANSWERING SERVICE

Group Art Unit: 2645

Examiner: PHAN, J.

SIR:

Attached hereto for filing are the following papers:

APPEAL BRIEF

Our credit card payment form in the amount of **\$340.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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Application No. 09/622,593
Reply to Office action of: October 9, 2003

DOCKET NO.: 194667US2PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
BO OLSSON, ET AL. : EXAMINER: PHAN, J.
SERIAL NO: 09/622,593 :
RCE JULY 30, 2003 : GROUP ART UNIT: 2645
FILED:
FOR: PROCEDURE TO TRANSMIT :
INFORMATION AT TELEPHONE
ANSWERING SERVICE

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants appeal the outstanding Office Action mailed May 21, 2004, rejecting each of pending Claims 1-10.

I. REAL PARTY IN INTEREST

The above-noted application is assigned to TELIA AB, which is the real party in interest, having a place of business at Marbackagatan 11, S-123 86, Farsta, Sweden.

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II. RELATED APPEALS AND INTERFERENCES

Applicants and Applicants' representative are not aware of any related judicial proceedings, appeals or interferences that will directly effect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-10 are pending in the present application and the rejection of each of Claims 1-10 is being appealed.

IV. STATUS OF AMENDMENTS

On September 29, 2004, an amendment was filed subsequent to the Office Action mailed May 21, 2004, to amend Claims 1-4 and 9 and thereby overcome the rejection under 35 U.S.C. § 112, second paragraph. At this time we have no indication that the amendment has been received or considered by the Examiner. The claims on appeal are the amended claims as filed in the amendment.

V. SUMMARY OF THE INVENTION

The Applicants recognized that a problem exists in the background art that when a called subscriber in a mobile phone system is notified that a calling subscriber has left a recorded speech message, that notification may include a phone number of the calling subscriber. However, in the background art the called subscriber does not necessarily know to whom the phone number belongs, when listening to the recorded speech message. Further, in the background art the calling subscriber is unable to leave other information for the called subscriber that may be more suitably displayed as text. (Specification at page 2, lines 2-22).

As discussed in the present specification, the present invention solves drawbacks in the background art by making it possible for a remote answer device to store information

from a calling subscriber and to transmit this stored information to the called subscriber when the called subscriber listens to a recorded speech message left by the calling subscriber. The stored information is transmitted in parallel with the transmission of the recorded speech message so that the stored information is conveniently available for use by the called subscriber when the called subscriber listens to the recorded speech message. (Specification at page 2, line 33, to page 3, line 5).

Claim 1 sets forth, with reference to Figure 1 as a non-limiting example, a procedure to transmit information in connection with a telephone answering service which is provided by a remote answer device in a mobile telephone system. As shown in the example of Figure 1, the procedure includes connecting a Calling Subscriber to the Mobile Answer (e.g., remote answer device) when a called subscriber can not be accessed. Further, the procedure includes storing information (e.g., A-number or call-back number) that originates from the Calling Subscriber in Memory on the Mobile Answer, and storing a Speech Recording (e.g., recorded speech message) on the Mobile Answer. The procedure of this example also includes transmitting a text message containing the stored information to a Called Subscriber via an SMS protocol, in parallel with transmitting the Speech Recording to the Called Subscriber. (Specification at page 4, lines 26-30). The Speech Recording and the stored information are transmitted to the Called Subscriber when the called subscriber establishes a wireless connection to the remote answer device to listen to the Speech Recording. (Specification at page 3, lines 16-20).

Claim 9 sets forth features similar to those of Claim 1, but is directed to a method of transmitting information between a calling subscriber and a called subscriber in a mobile telephone system.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The only issue outstanding in the present application is whether the teachings of U.S. Patent No. 6,333,973 to Smith et al. (herein "Smith") anticipate the subject matter of each of Claims 1-10 under 35 U.S.C. § 102(e).

VII. ARGUMENTS

Claims 1 and 9 as rejected under 35 U.S.C. § 102(e)

In supporting the outstanding rejection under 35 U.S.C. § 102(e) as anticipated by Smith, the outstanding Office Action states:

Regarding claims 1 and 9, Smith teaches a procedure and method to transmit information in connection with a telephone answering service which is provided by a mobile answer device in a mobile telephone system characterized in the steps:

...

transmitting a text message containing the stored information, in parallel to transmitting recorded speech messages from the calling subscriber, to the called subscriber (col. 7 lines 40-56) when the called subscriber requests a wireless connection to the mobile answer device to listen to recorded speech messages (Fig. 10, col. 8 line 26 [to] col. 9 line 5, and col. 9 lines 35-43).¹

However, the above-noted grounds for the rejection under § 102(e) erroneously construes the cited reference as teaching the features recited in Claims 1 and 9.

Claim 1 is directed to a procedure to transmit information in connection with a telephone answering service that is provided by a remote answer device in a mobile telephone system. The procedure includes connecting a calling subscriber to the remote answer device

¹ Office Action mailed May 21, 2004, at page 3, lines 13-23.

when a called subscriber can not be accessed and storing information that originates from the calling subscriber on the remote answer device.

Further, the procedure of Claim 1 includes transmitting a text message to the called subscriber in parallel to transmitting recorded speech messages to the called subscriber. The text message contains the stored information that originates from the calling subscriber. In addition, the text message and recorded speech messages are transmitted when the called subscriber establishes a wireless connection to the remote answer device to listen to the recorded speech messages.

In a non-limiting example, the specification states that stored information is “transmitted, not as previously at notification, but at the listening to the messages. This is done via SMS or USSD (Unstructured Supplementary Services Data) which uses signaling channels which transfer information in parallel with the speech service.”² That is, in this example, stored information from the calling subscriber is transmitted to a called subscriber in parallel to the transmission of the recorded speech message to the called subscriber. Further, the stored information from the calling subscriber is not transferred to the called subscriber upon notification that a message has been stored, as in the background art.

An advantage of this approach is that “the telephone number from [a] calling subscriber is transmitted to the voice mailbox subscriber via SMS or USSD, at the same time as the subscriber listens to recorded mobile answer messages”³ thereby allowing convenient transfer of telephone numbers and other information from calling subscribers to called subscribers.⁴

² Specification at page 4, lines 26-30.

³ Specification at page 6, lines 13-16.

⁴ Specification at page 6, lines 29-31.

Smith is directed to an integrated message center that consolidates messages of different types (e.g., voice, fax and email) for viewing and manipulation by a user. However, Smith describes only two conventional methods for transmitting stored information to a called subscriber. In the first method, Smith indicates that the

SMS server 5300 formulates an SMS voice mail notification message to notify the user of the voice mail message. The voice mail notification message might include the caller's name and telephone number, a time and date stamp, and the name and address of voice mail server 5600.⁵

Thus, in this method, Smith indicates that stored information is transmitted to the called subscriber upon notification, which is different than the claimed procedure of transmitting the stored information to the called subscriber in parallel to transmitting the recorded speech messages.

Alternatively, Smith also indicates that "[i]f the user desires, message center 6100 will provide more detailed information about any of the received messages *before* retrieving the actual message" (emphasis added).⁶ Hence, with this second method, Smith indicates that stored information is transmitted to the called subscriber *before* retrieving the recorded speech messages, which is different than the claimed procedure of transmitting the stored information to the called subscriber in parallel to transmitting the recorded speech messages.

Further, the sections of Smith cited in the outstanding Office Action as teaching the claimed invention merely point out conventional elements of retrieving stored messages, as discussed above. Accordingly, it is respectfully submitted that Smith does not teach or suggest "transmitting a text message containing the stored information, in parallel to transmitting recorded speech messages from the calling subscriber, to the called subscriber

⁵ Smith at column 7, lines 50-56.

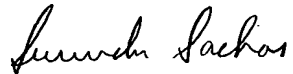
⁶ Smith at column 8, lines 52-54.

when the called subscriber establishes a wireless connection to the remote answer device to listen to recorded speech messages,” as recited in independent Claims 1 and 9.

For the foregoing reasons, Applicants respectfully submit that independent Claims 1 and 9 patentably define over Smith, and that therefore Claims 1 and 9, and claims depending therefrom, are allowable. Therefore, the outstanding rejection must be REVERSED.

Respectfully submitted,

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CLAIMS APPENDIX

Claim 1 (Previously Presented): A procedure to transmit information in connection with a telephone answering service which is provided by a remote answer device in a mobile telephone system comprising:

connecting a calling subscriber to the remote answer device when a called subscriber can not be accessed;

storing information that originates from the calling subscriber on the remote answer device; and

transmitting a text message containing the stored information, in parallel to transmitting recorded speech messages from the calling subscriber, to the called subscriber when the called subscriber establishes a wireless connection to the remote answer device to listen to recorded speech messages.

Claim 2 (Previously Presented): The procedure as claimed in claim 1, wherein the stored information includes the calling subscriber's number, which is transferred automatically to the remote answer device.

Claim 3 (Previously Presented): The procedure as claimed in claim 1, wherein the stored information includes one message stored in advance at the calling subscriber, which is transferred automatically to the remote answer device.

Claim 4 (Previously Presented): The procedure as claimed in claim 1, wherein the stored information contains an optional number, which is transferred by the calling subscriber to the remote answer device.

Claim 5 (Previously Presented): The procedure as claimed in claim 1, wherein the text message is connected to an application at the called subscriber's mobile terminal.

Claim 6 (Previously Presented): The procedure as claimed in claim 5, wherein the application connects a number with a telephone list.

Claim 7 (Previously Presented): The procedure as claimed in claim 1, wherein the text message is transmitted by a short text message service.

Claim 8 (Previously Presented): The procedure as claimed in claim 7, wherein the short text message service is an SMS (Short Message Service) or a USSD (Unrestricted Supplementary Services Data).

Claim 9 (Previously Presented): A method of transmitting information between a calling subscriber and a called subscriber in a mobile telephone system, comprising:

- connecting a calling subscriber to a remote answer device when a called subscriber cannot be reached;
- storing information that originates from the calling subscriber on the remote answer device; and
- transmitting a text message containing the stored information, in parallel to transmitting recorded speech messages from the calling subscriber, to the called subscriber

when the called subscriber establishes a wireless connection to the remote answer device to listen to recorded speech messages.

Claim 10 (Previously Presented): The method as in claim 9, further comprising:
transmitting the text message as a SMS (Short Message Service) or as a USSD
(Unrestricted Supplementary Services Data).

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.